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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,501	07/20/2001	Steven C. Johnson	10003562-1	4153

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
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EXAMINER

ARTHUR JEANGLAUDE, GERTRUDE

ART UNIT PAPER NUMBER

2144

DATE MAILED: 06/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/909,501	Applicant(s) JOHNSON ET AL.	
	Examiner Gertrude Arthur-Jeanglaude	Art Unit 2144	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Response to Amendment

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-18, 20, are rejected under 35 U.S.C. 102(e) as being anticipated by Santamaki et al. (U.S. patent No. 6,886,036).

As to claim 1, Santamaki et al. disclose an electronic service transaction apparatus comprising a computer peripheral device as shown in Figs 1-3 having a communication link with an electronic service site and a messaging system (e-mail) (See col. 4, lines 46-67) configured to communicate between the computer peripheral device and the electronic service site and operative to enable sending and receiving of at least one of messages and information between the computer peripheral device and the electronic service site wherein the communication link connects the computer peripheral device with the Internet, and the messaging system is accessed directly by the computer peripheral device to initiate an electronic service transaction from the computer peripheral device with the electronic service site (See col. 12, lines 22-43).

As to claim 2, Santamaki et al. disclose the computer peripheral device comprises an embedded web server as shown in Fig. 9 via Internet (80) and wherein the embedded web server forwards a request for an electronic service to the electronic service site from the computer peripheral device via the messaging system (email) (See col. 4, lines 56-67; col. 8, lines 42-67).

As to claim 3, Santamaki et al. disclose the computer peripheral device comprises a messaging system that enables initiation of an electronic service transaction from an electronic service site (See col. 8, lines 24-67).

As to claim 4, Santamaki et al. disclose the communication link comprises an electronic communication link provided by a mail client of the computer peripheral device that enables a user to submit an e-mail order using a mail program from the computer peripheral device to an external provider of electronic services (See Fig. 4; col. 4, lines 46-67).

As to claim 5, Santamaki et al. disclose the use of e mails for messaging wherein it is inherent to use a mail program (See col. 4, lines 46-67) operative to enable sending and receiving of at least one of messages and information between the computer peripheral device and an external electronic service site.

As to claim 6, Santamaki et al. disclose the messaging system comprises a dedicated Internet connection as shown in Fig.7.

As to claim 7, Santamaki et al. disclose the computer peripheral device connects with an external server via the Internet (80) as shown in Fig. 7, the computer peripheral device accesses a document on the external server (30) to render a web page, and the

electronic service transaction comprises sending a URL for the document to the electronic service, and receiving a print stream (See Fig. 2) from the external server for the document.

As to claim 8, Santamaki et al. disclose the computer peripheral device automatically generates a consumable order message in response to the computer peripheral device detecting a need to replenish a consumable and further forwards a notification to a consumable order web site on an external web server indicating a need to replenish the consumable (See col. 7, lines 37-58).

As to claim 9, Santamaki et al. disclose the computer peripheral device comprises a printer connected with the Internet via the communication link, wherein a user accesses a document on the Internet via the printer and prints the document using the printer (See col. 5, lines 56-67- col. 6, line 51). .

As to claim 10, Santamaki et al. disclose a computer peripheral device, comprising: an output engine (printer ; see Fig. 2); a transaction execution subsystem communicating with the output engine; a communication interface (communication link) communicating with the transaction execution subsystem; and processing circuitry ((CPU 510 shown in Fig.6) communicating with the transaction execution subsystem and operative to initiate an electronic services transaction from the transaction execution subsystem using the communication interface via an external network with an electronic services provider (See Fig.9; See col. 12, lines 22-43).

As to claim 11, Santamaki et al. disclose the computer peripheral device wherein the output engine comprises a print engine (See Figs.2-3)) communicating with the transaction execution subsystem.

As to claim 12, Santamaki et al. disclose the computer peripheral device wherein the communication interface comprises a user interface (10) as shown in Fig.1 of a computer peripheral device.

As to claim 13, Santamaki et al. disclose the computer peripheral device wherein the transaction execution subsystem comprises an embedded web Server (See col. 4, lines 56-67; col. 8, lines 42-67).

As to claim 14, Santamaki et al. disclose the computer peripheral device wherein the processing circuitry is provided by a central processing unit (CPU) (See Fig. 6, #510), and the CPU is further operative to carry out an e-services transaction using the transaction execution subsystem of the computer peripheral device.

As to claim 15, Santamaki et al. disclose a method of initiating an electronic services transaction, comprising: providing a computer peripheral device having a communication link with an electronic service site and an interface system for initiating an electronic service transaction between the computer peripheral device and the electronic service site; detecting a need to initiate an electronic service transaction from the computer peripheral device with an external electronic service site; and initiating an electronic service transaction in response to the detected need using the computer peripheral device (See col. 12, lines 22-43).

As to claim 16, Santamaki et al. disclose the computer peripheral device comprises an embedded web server, the electronic service site comprises a site web server and the communication link comprises an Internet messaging system extending between the computer peripheral device and the site server (See col. 4, lines 56-67; col. 8, lines 42-67).

As to claim 17, Santamaki et al. disclose detecting a need for an electronic services transaction comprises receiving a user input at a user interface of a computer peripheral device that initiates an e-services transaction.

As to claims 18, 20, Santamaki et al. disclose the computer peripheral device comprises a printer wherein the printer completes an electronic services transaction with the electronic service site (See col. 5, lines 56-67- col. 6, line 51).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Santamaki et al. (US 6,886,036) in view of Christensen (US 5,862,431).

As to claim 19, Santamaki et al. disclose all but fail to specifically disclose detecting a need for an electronic services transaction comprises detecting a need to

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order toner. In an analogous art, Christensen discloses a toner detecting system with a toner sensing element that can be used obviously to detect a need to order toner (See abstract; col. 5, lines 1-5). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Santamaki et al. with that of Christensen by having a toner detecting system in order to detect the toner level condition and to obviously order more supplies.

Response to Arguments

Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gertrude Arthur-Jeanglaude whose telephone number is (571) 272-6954. The examiner can normally be reached on Monday-Friday from 8:30 a.m. to 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wiley David can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GAJ

GAJ

June 8, 2005

Gertrude A. Jeanglaude
GERTRUDE A. JEANGLAUE
PRIMARY EXAMINER